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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,505	06/04/2001	Hongjie Cao	1928.PC	4692

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 03/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/873,505

Applicant(s)

CAO ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Receipt is acknowledged of Amendment filed on December 19, 2001. Claims 1-25 are pending. Part of the claim rejection under 35 U.S.C. § 112 is withdrawn in view of the amendment by applicants. Claim rejection under 35 U.S.C. § 102 withdrawn in view of applicants' remarks. Claim rejections under 35 U.S.C. § 103 are maintained for the reasons of record as indicated in the previous office action dated September 17, 2001.

#### ***Claim Rejections - 35 USC § 112***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "vitamins vitamin A, D, E, and K" is vague and confusing. Applicants deleted the term "such as" in line 3 of the claim in response to the rejection from the previous office action, but it is still unclear whether the recited the specific types of vitamins following the term "vitamin" are part of the claimed invention. See MPEP § 2173.05(d).

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

(A) Claims 1-4, and 8-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wurzburg et al. ("Modified Starches: Properties and Uses", 1986) ("Wurzburg") in view of Eskin et al. (U.S. Pat. No. 5,882,713) ("Eskin").

Rejection is maintained for reasons of record.

(B) Claims 3, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wurzburg and Eskin, as applied to claims 1, 2, 8-21, and 23-25 above, and further in view of Roulier et al. (EP 0938892 A1, Translation) ("Roulier").

Rejection is maintained for reasons of record.

(C) Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wurzburg, Eskins and Roulier as applied to claims 1-3 and 5-25 above, and further in view of Fletcher et al. (U.S. Pat. No. 6,261,543 B1) ("Fletcher").

Rejection is maintained for reasons of record.

### ***Response to Arguments***

Applicant's arguments filed in response to office action dated September 17, 2001, have been fully considered. Examiner finds that applicants' argument in reference to 35 U.S.C. § 103 rejections are not persuasive, as discussed below.

#### **1. Rejection over Wurzburg in view of Eskin**

Specifically, applicants argue that Wurzburg fails to show prima facie obviousness of the present invention because the starch-encapsulated compounds there are water sensitive and not stable in water. In response, examiner notes that the reference further goes on to state that "it is desirable to obtain powders with water-repellent properties for a more gradual or controlled release of the encapsulated

materials" in certain applications including deodorant sprays. See Wurzburg, p. 141, second paragraph lines 5-7. The issue in this case is, whether, given the general teaching of starch encapsulation of water-repellent actives in Wurzburg, it would have been obvious to a skilled worker to use the techniques and materials taught in Eskin. Examiner maintains the position that, in view of the teaching in Eskin that the non-separable composition of starch and oil produced with its method provides benefits such as stability and smoothness when dispersed in water, the routineer would have been motivated to apply the teachings of Eskin.

Applicants further argue that Eskin does not enable cosmetic or personal care products. Examiner takes the position that whether a prior art expressly enables a claimed invention is not the standard to determine the obviousness of the claimed invention. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). As stated in the previous action, Eskin teaches the application of the invention in the enlisted personal care and cosmetic products in col. 13, lines 55-53. Examiner asserts that one having ordinary skill in the art would have found motivation and suggestion to modify the illustrated examples in Eskin by using the disclosed technique and components to formulate personal care or cosmetic products.

Applicants also argue that a mere fact that a reference can be modified does not render the modification obvious unless the references suggest the desirability of the modification. Examiner notes that both Wurzburg and Eskin teach the desirability of the modification in this case, as discussed above: Wurzburg suggests using water-repellent

encapsulation for more controlled release of the actives for particular applications, as opposed to water-sensitive powders; Eskin teaches stability, smoothness, lump-free, and non-greasiness of the products of its invention.

In response to applicant's argument that references must suggest the success of the modification, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Again, the test is rather what the combined teachings of the references would have suggested to those of ordinary skill in the art.

**2. Rejection in view of Wurzburg and Eskin in view of Roulier**

Applicants assert that the invention in Roulier is anhydrous, dry power, and not a stable aqueous formulation. Examiner notes that the reference in fact teaches that the powder containing oil actives may be "incorporated in a cosmetic and/or dermatological composition which is in another galenic form, such as a lotion, W/O or O/W emulsion". See Roulier, English translation, p. 7, [0042].

**3. Rejection over Wurzburg, Eskin, and Roulier in view of Fletcher**

Applicants argue that Fletcher fails to disclose a starch-encapsulated hydrophobic compound or a stable aqueous personal care or cosmetic formulation and does not cure the deficiencies of the other combined references. Examiner takes the position that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As discussed in the previous office action, the combined references suggest of using modified starches. See Eskin, col. 7, lines 3 – 28. Given this general teaching and the particular teaching of the cationically-modified starches suitable for aqueous emulsions for cosmetic, one having ordinary skill in the art would have been motivated to use the modified starches in Fletcher.

Examiner notes that applicants have not demonstrated unexpected results of the obvious combination of the well-known ingredients. See MPEP 706.12. Absent unexpected results to show nonobviousness of the present invention, the rejections are maintained.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

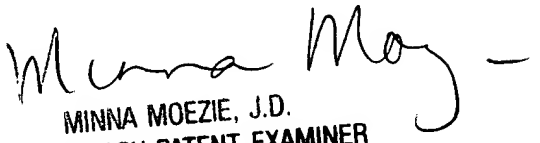
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
March 19, 2002

  
MINNA MOEZIE, J.D.  
SUPERVISORY PATENT EXAMINER  
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